

REMARKS

In the aforesaid Office Action, the claim for priority as a divisional application was temporarily withdrawn, the proposed drawing of Fig. 8 was not approved and was objected to as introducing new matter, claims 22-25 were rejected under 35 USC 112, second paragraph, claims 22-23 were rejected under 35 USC 102(b) as being anticipated by Atkinson et al. (5,256,145), and claim 25 was rejected under 35 USC 103(a) as being unpatentable over Atkinson et al. in view of Burns et al. (5,176,698). Claims 22, 24 and 25 are pending.

Applicants appreciate the courtesies extended by the Examiner in the telephone interview on July 12, 2004, conducted between Applicant's representative, Priscilla Morrison, and the Examiner. Applicant's summary of the interview is given below.

In the July 12, 2004 interview, Figs. 2 and 8 of Applicant's application, were discussed. Applicant's requested clarification of the nature of the objection to the proposed amendment of Fig. 8. The Examiner stated that it was unclear if element 27 in Fig. 2 was the "sheath" as claimed. Applicant stated that element 27 in Fig. 2 is the balloon distal section and is not the sheath as claimed. Applicant's agreed to specifically identify the disclosure which supports the proposed amendment to Fig. 8, and proposed amending the claims to specifically recite both the balloon distal section and the sheath.

The Examiner refused entry of the proposed amendment to Fig. 8, stating the drawing is not the originally elected embodiment, and objected to the 3/15/04 amendment under 35 USC 132, stating that new Fig. 8 has not been approved because it introduces new matter. However, the proposed amendment to Fig. 8, repeated here, is fully supported by the specification as filed. Specifically, proposed amended Fig. 8 illustrates a sheath 40 on the tip member 14 with the distal end of the balloon distal section located proximally adjacent to the sheath, and in the second paragraph of the Detailed Description of the parent application as filed (USSN 09/471,053, filed December 21, 1999) the specification discloses that a sheath located distally adjacent to the distal end of

the balloon distal section 27 could be disposed about and secured to the inner tubular member 21 or tip member 14 in place of the distal end of the balloon distal section 27. The proposed amendment to Fig. 8 is the originally elected embodiment. Specifically, Applicant's elected the species of Fig. 8 which illustrated a sheath 40 on the tip member 14. Although the original Fig. 8 illustrated the sheath 40 on both the tip member 14 and the inner tubular member 21, and proposed amended Fig. 8 illustrates the sheath 40 on only the tip member 14, the proposed amended Fig. 8 is the originally elected embodiment because it is directed to an embodiment having sheath 40 on the tip member 14. The remaining figures (Figs. 1-7) do not illustrate the sheath 40.

The Examiner rejected claims 22-25 under 35 USC 112, second paragraph. Applicants have amended claim 22 to obviate the rejection.

The Examiner rejected claims 22-23 under 35 USC 102(b) as being anticipated by Atkinson et al., and claim 25 under 35 USC 103(a) as being unpatentable over Atkinson et al. in view of Burns et al., stating that Atkinson et al. discloses a balloon 82 on the distal shaft section of the balloon catheter, a tip member 88 secured to the distal end of the balloon catheter and spaced distally apart from the elongated catheter shaft, and a sheath 98 which is disposed about the tip of the member or the elongated shaft.

However, Atkinson et al. does not disclose or suggest a tip member having a lumen which extends to a port in the tip member distal end. Instead, Atkinson et al. illustrates the tip member 88 with a closed distal end, and discloses that the tip member distal end is welded to the guidewire shaping ribbon (see col. 4, lines 10-20). Moreover, Atkinson et al. does not disclose or suggest a catheter having the balloon distal section secured to the tip member. Instead, in Atkinson et al. the distal end of the balloon is located proximal to the tip member 88 so that only the sheath 98 is disposed about the tip member 88.

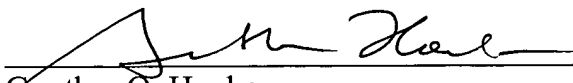
The priority claim of the application was temporarily withdrawn by the Examiner. Applicant hereby confirms the claim for priority as a continuation (not a CIP) application.

As discussed above, the proposed amended Fig. 8 is fully supported by the parent case (USSN 09/471,053), and therefore, the present application is a straight continuation application and not a CIP.

In light of the above amendments and remarks, applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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